APPENDIX

No. 16592

UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

MINNESOTA MINING AND MANUFACTURING COMPANY,
Plaintiff-Appellant,

v.

NORTON COMPANY,
STUDEBAKER-PACKARD CORPORATION,

and

HADCO CORPORATION,
Defendants-Appellees.

APPEAL from the U. S. District Court
for the Northern District of Ohio.

Decided September 13, 1966.

Before WEICK, Chief Judge, O'SULLIVAN and CELEBREZZE, Circuit Judges.

O'SULLIVAN, Circuit Judge. This is an appeal by Minnesota Mining and Manufacturing Company (referred to herein as Minnesota) from a summary judgment which dismissed its suit against appellees, Norton Company, Studebaker-Packard Corporation and Hadco Corporation (referred to herein collectively as Norton) for infringement of a Minnesota patent. The dismissal was bottomed

upon the District Judge's conclusion that Minnesota's act of filing several applications for foreign patents on the invention in suit without obtaining a license to do so from the Commissioner of Patents rendered the patent subsequently obtained in this country invalid. This was held to violate the provisions of 35 U.S.C.A. §§ 184 and 185.[1] The District Judge held that a retroactive license for such foreign filing, obtained pursuant to the provisions of section 184, during the pendency of the litigation, was ineffective to save the patent because it had not been obtained prior to the issuance of the United States patent in suit. *Minnesota Mining and Manufacturing Co.* v. *Norton Company*, 240 F. Supp. 150 (N.D. Ohio, E.D. 1965).

---

[1] "§ 184. *Filing of application in foreign country.* Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term 'application' when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof."

"§ 185. *Patent barred for filing without license.* Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184, of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid."

Section 184 forbids application for a foreign patent on an invention made in this country prior to six months after application for the United States patent "except when authorized by a license obtained from the Commissioner [of Patents]." This section is part of the *Invention Secrecy Act* of 1951, 35 U.S.C.A. §§ 181-188, enacted by Congress to prevent the publication and disclosure in a foreign country of an invention upon which a patent is sought in this country where such disclosure would "be detrimental to the national security." 35 U.S.C.A. § 181. The six month period before foreign application can be made and the requirement of a license for a foreign filing within such period are designed to provide opportunity for the Commissioner of Patents, if he thinks the disclosure might "be detrimental to the national security," to submit the application to the Atomic Energy Commission, the Secretary of Defense and other agencies concerned with national defense, in order that they may inspect the invention and determine whether its foreign disclosure might indeed "be detrimental to the national security." If such a determination is made, the mentioned section provides that the Commissioner "shall order the invention be kept secret and shall withhold the grant of a patent for such period as the national interest requires * * *."

Section 185 provides that any person who makes application for a foreign patent "without procuring the license prescribed in Section 184" shall not receive a United States patent for the involved invention and a "United States patent issued to such person * * * shall be invalid." Section 184, however, provides that "the license may be grantd retroactively when an application has been *inadvertently filed abroad* and the application does not disclose an invention *within the scope of* Section 181 of this title." (Emphasis added.) Minnesota did obtain a license for foreign filing made retroactive to the dates upon which the foreign filings were made. The question for our decision is whether such retroactive license was ineffective

because it was obtained after the issuance of the United States patent. The District Judge answered in the affirmative. We reverse.

The invention of the patent in suit may be shortly described as a scouring pad containing properties and design that allegedly provide revolutionary improvement over prior techniques of polishing, scrubbing and buffing. Its most common usages are in floor maintenance, household and kitchen care, and in metal finishing and polishing. Infringement by defendant-appellees of the patent granted on such invention was the claim of Minnesota's dismissed complaint.

Steps to obtain the patent before us, Hoover, et al., U.S. No. 2,958,593, began with a first application on February 21, 1957, which disclosed the first eight claims of the patent, which are the claims in suit. More than six months later and without any intervening application for a foreign patent, a second application, a "continuation in part" of the original, was filed on October 8, 1958. This added disclosure of a further embodiment of the basic invention—Claims 12 and 13. On January 8, 1959, within six months of the filing of this second application, Minnesota's patent counsel applied for a license to file patent applications "in all countries" and on February 5, 1959, such license was granted. This license was not retroactive as there appeared to be no need therefor. A third application was filed in the U. S. Patent Office on January 11, 1960, as a continuation in part of the first two, setting out Claims 9, 10 and 11. No application for foreign filing under the final application was made and the patent in suit was issued on November 1, 1960, on this last application.

The complaint here was filed on August 28, 1961, and after many intervening procedural steps, Norton, on December 23, 1964, moved for summary judgment and to amend its answer on the newly discovered fact that within the several dates, January 19, 1959, to January 24, 1959,

Minnesota's Chicago patent counsel had forwarded to five countries applications for foreign patents on the involved invention. These dates followed the January 8, 1959, application for license to make such filings but were prior to the February 5, 1959, issuance of the license by the Commissioner. The premature foreign filings came to light when Minnesota, on December 15, 1964, was obtaining information to make response to interrogatories. Minnesota's counsel forthwith, on December 22, 1964, applied to the Commissioner of Patents for a retroactive license to cover the inadvertent foreign filings made between January 8, 1959, when request for a license was made and February 5, 1959, when a non-retroactive license was issued. The Commissioner of Patents granted the needed retroactive license on January 8, 1965; such license reciting that it was "retroactive to January 8, 1959," a date preceding the inadvertent foreign filings of January 19-24, 1959. The granting of the license constituted the Commissioner's finding that the premature foreign filings were inadvertent and that disclosure of the involved invention was not detrimental to the national security. These questions have been legislatively delegated to the Commissioner and his findings are not here challenged.

When the case was called for trial on January 4, 1965, with appellee Norton's motion for summary judgment on its amended answer undisposed of, appellant Minnesota informed the Court of its pending application for a retroactive license. Being of the view that such a license would not avail to sustain Minnesota's patent, the Court delivered an opinion from the bench holding the patent invalid. He did, however, entertain Minnesota's motion for reconsideration after it received its license on January 8, and on March 10, 1965, reaffirmed his original view in a formal opinion upon which the judgment on appeal was entered.

The District Judge based his ruling on a view that the retroactive license would be effective to cure the defect

created by the untimely foreign filing only up to the point when the United States patent actually issued. After noting that Section 185 states: "notwithstanding any other provision of law * * *. A United States patent issued to such person [one who has impermissibly filed abroad] * * * shall be invalid" he concluded, "The plain fact is that the patent did issue without a license and must be deemed invalid *ab initio*. *Without specific authorization from Congress*, the Commissioner is powerless to affect the validity or invalidity of a patent after it has egressed from administrative channels. Consequently, the purported retroactive license issued on January 8, 1965, is inoperative * * *." (Emphasis supplied)

However, Section 184 itself is such "specific authorization from Congress." By its Act, Congress provided:

> "The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title."

This is clear language and we are unable to read into it the restriction relied on by appellee and imposed by the District Judge, viz: that the Commissioner's authority to grant the license ends once the patent has issued. The only restriction imposed on the Commissioner is that he must find inadvertence in the foreign filing and that disclosure of the invention would not be detrimental to the national security.

Appellee Norton argues that the beginning and concluding language of Section 185, to wit: "Notwithstanding any other provision of law * * *," and "a United States patent issued to such person [one who filed abroad without the license prescribed in Section 184] * * * *shall be invalid*," must mean that once a patent has issued without *antecedent* compliance with § 184, its validity is forever destroyed. But, to the contrary, the statute in clear language provides for *retroactive* compliance, and when

such *retroactive* compliance is supplied, the *retroactive* license must be taken as standing in its proper place in the sequence of: (1) U. S. application, (2) license, (3) foreign application, and (4) U. S. Patent.

The District Judge found Congressional intent to limit the granting of a retroactive license to the period prior to the issuance of the patent by emphasizing that had it intended otherwise, the second use of the word "application" in the relevant portion of § 184 would have been followed by "or patent". We are not sure we understand this contention, but whether the second "application" refers to the foreign or the domestic application, the license when granted retroactively by the Commissioner, assumes its required position ahead of the foreign filing in the order of procedure.

Both parties have, in addressing this Court, discussed the legislative history of §§ 184 and 185 of the *Invention Secrecy Act* of 1951 to support their respective contentions. We consider that Congress spoke plainly in its statute. We look for Congressional intent in its clear language. *U. S.* v. *Oregon,* 366 U.S. 643, 648 (1961); *Hilliard* v. *U. S.,* 310 F(2) 631, 632 (CA 6, 1962); *U. S.* v. *Redmond,* 328 F(2) 707, 710-11 (CA 6, 1964).

Much reference has been made to the so-called Boykin Act, (Act of August 8, 1946, 60 Stat. 940) which in its Section 6 clearly provided that an unauthorized foreign filing would not render an issued patent invalid, if subsequent authorization was obtained from the Commissioner. The District Judge and appellee concede that were the Boykin Act now in force, the Commissioner's retroactive license would sustain the patent in suit. Appellant, Minnesota, contends that the rule of the Boykin Act is contained in §§ 184, 185 of the 1951 Act. Appellee Norton argues that Boykin and its rule were purposefully repealed without incorporation into the Act before us. We do not consider resolution of this contest necessary here, satisfied that

both the Boykin Act and the 1951 Act disclose Congressional willingness that the Commissioner do what he did here, even after the issuance of a patent.

The Commissioner of Patents has, by granting retroactive licenses after a patent has issued, expressed an administrative interpretation contrary to the decision we review. Such contrary interpretation has also been the holding of whatever courts have had occasion to rule on the question. *Union Carbide Corp.* v. *Microton,* 149 U.S.P.Q. 827 (W.D. N.C. 1966); *Barr Rubber Products Co.* v. *The Sun Rubber Co.,* 149 U.S.P.Q. 204 (S.D. N.Y. 1966); *Pillsbury Co.* v. *General Mills, Inc.,* 148 U.S.P.Q. 487 (D.C. Minn. 1966); *Blake* v. *Bassick Co.,* 245 F. Supp. 635, 146 U.S.P.Q. 160 (N.D. Ill., 1965); *Pillsbury Co.* v. *Brenner,* 146 U.S.P.Q. 99 (D.C. D.C., 1965); *McCormick* v. *Brenner,* 146 U.S.P.Q. 340 (D.C. D.C., 1965); *Davidson Rubber Co., Inc.* v. *Sheller Mfg. Co.,* 147 U.S.P.Q. 511 (S.D. Iowa, 1965); *Engelhard Industries, Inc.* v. *Sel-Rex Corp.,* 145 U.S.P.Q. 319 (D.C. N.J. 1965); *Nordberg Manufacturing Co.* v. *Jackson Vibrators, Inc.,* Civil No. 63C2250 N.D. Ill. Feb. 10, 1966 (letter opinion); *McCulloch Motors Corp.* v. *Oregon Chain Saw Corp.,* 245 F. Supp. 851 (S.D. Cal. 1963); *Blake* v. *Bassick Co.,* 146 U.S.P.Q. 157 (N.D. Ill., 1963); *In re Rinker and Duva,* 145 U.S.P.Q. 156 (Comm'r of Patents, 1964). See also Mich. L. Rev. 496 (1966); 34 Geo. Wash. L. Rev. 373 (1965).

The case relied upon most heavily by appellees, *Beckman Instruments, Inc.* v. *Coleman Instruments, Inc.,* 338 F(2) 573 (C.A. 7, 1964) is not material since it did not deal with the question of the effect of a retroactive license. That case stands only for the proposition that if neither the ordinary nor the retroactive license provided for in Section 184 has been procured, untimely foreign filing is an effective defense in an infringement suit.

Norton suggests that a retroactive curing of the defect here involved would leave unanswered the question whether

there could have been any actionable infringement between the issuance of the patent and the grant of the retroactive license. Lest this point be further litigated upon remand, we hold that the defect of premature filing has been cured as of the date provided in the retroactive license, viz: January 8, 1959.

The judgment is reversed and the cause is remanded for further proceedings consistent herewith.

Opinion

U. S. DISTRICT COURT FOR NORTHERN DISTRICT OF OHIO, EASTERN DIVISION

Filed March 10, 1965

CONNELL, *C. J.*:

The history of this patent begins on February 21, 1957, when the plaintiff filed in the United States Patent Office an application which became Serial No. 641714. On October 8, 1958, the plaintiff filed an application for patent in the names of its employees Howard L. Hoover, Eugene J. Dupre and Walter J. Rankin, Application No. 777,167, which application contained matter related to a certain extent to the subject matter of the earlier application, but which contained certain substantial additional subject matter. In the month of January 1959, less than six months after the filing of Application 777,167, the plaintiff caused to be filed Applications for Patent in five foreign countries which applications involved substantially the same subject matter. Application was made in Sweden on January 19, 1959, in Australia on January 20, 1959, in Argentina and Italy on January 22, 1959, and in Japan on January 24, 1959. On January 12th of 1959 the United States Patent Office received from a Chicago law firm (Langner, Parry, Carr & Langner) a request for a license for the filing of foreign applications based on U. S. Application 777,167. Thus, from the stipulated facts before us, (2) it is appar-

ent that the plaintiff did not await the arrival of the license before filing in these five foreign countries. On February 9, 1959, the Patent Office issued a license dated February 5, 1959, which stated that the license was not retroactive.

On January 4, 1965 this Court conducted an oral hearing on the defendants' motion for summary judgment. At that time the defendants pointed out that the plaintiff had violated the provisions of Title 35, §§ 184 and 185 because they had failed to obtain a license from the Patent Office to file applications in foreign countries. On the authority of *Beckman Instruments, Inc.* v. *Coleman Instruments, Inc.*, 338 F. 2d 573 (1964), we concluded that the six month waiting period described in § 184 begins to run from the date of filing of a "Continuation-in-Part" application; that the plaintiff, by filing in five foreign countries in January of 1959 without a license to do so, had thus violated the statute, and under the explicit language of § 185 the patent was necessarily invalid.

Subsequent to the Court's decision, present counsel for Minnesota Mining Company was successful in securing a retroactive license from the Patent Office, which purports to issue a license retroactive to January 8, 1959 with respect to Argentina, Australia, Italy, Japan and Sweden. Had this license been secured prior to the issuance of the patent, there is no doubt that it would have cured the infirmity created by the precocious filing in these foreign countries. The problem with which we are here faced is the present effect of a retroactive license upon a patent which has already issued from the Patent Office. Our question ultimately is one of jurisdiction, i.e., whether the Patent Office has the power to breathe life into an otherwise meaningless piece of paper.

Cases are filled with statements that "The only authority competent to set a patent aside, or to annul it, or to correct it for any reason whatever, is vested in the

courts of the United States and not in the (3) department which issued the patent." *McCormick Harvesting Machine Co.* v. *Aultman*, 169 U.S. 606, 609 (1898). However, under Article I, § 8 of the Constitution,[1] the power to confer jurisdiction ultimately resides in Congress. Congress outlines the function of the Patent Office and divides responsibilities between the administrative and judicial bodies. In arranging the division of duties, Congress has accorded the Patent Office some limited areas of jurisdiction where it can control or affect patents after their issuance. But, except for those specifically defined instances where a commissioner may reach out to assert his authority over an already issued patent, we think that he is precluded from doing so. As stated in McCrady, *Patent Office Practices*, 422, 4th Ed. 1959: "Issuance of a patent puts it *beyond the control of the Office* except for interference (§ 249 hereof), reissue (Chap. XXIV), Office reissue (§ 303), statutory disclaimer (§ 298-301), certification of correction (§ 302)."

Plaintiff has directed our attention to six cases[2] in which courts have in effect recognized the propriety of congressional acts which vest in the commissioner discretionary power over a patent even after it has issued from the Patent Office. With this we have no quarrel. These cases have three recurring characteristics: (1) the discretionary authority of the Patent Office is explicitly created by statute; (2) these courts by expressing a reluctance to in-

---

[1] "Congress shall have power * * * to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

[2] *Seymoure* v. *Osborne*, 78 U. S. 516 (1870); *Cregier* v. *Coe*, 67 F. 2d 692 (D. C. Cir. 1933); *Martin* v. *Robertson*, 39 F. 2d 520 (D. C. Cir. 1930); *Terry* v. *Webster*, 12 F. 2d 139 (D. C. Cir. 1926); *Wayne Mfg. Co.* v. *Coffield Motor Washer Co.*, 227 F. 987 (8th Cir. 1915).

trude upon the Patent Office's jurisdiction, recognize the clear lines of jurisdiction drawn by Congress; and (3) these courts confined the authority of the Patent Office to the express limits found in the statute. (*Cf.* especially *Terry* v. *Webster*, 12 F. 2d 139, 140 (D. C. Cir. 1926), where the court was quick to quash (4) an attempt by the Commissioner to enlarge the ambit of his authority.)

But this statute (§ 184) does not specifically provide for a grant of a retroactive license which can cure a patent which, by the mandatory language of the next section (§ 185), must be deemed invalid from its issuance. It is one thing for Congress to prescribe a method for forgiving an inadvertence within the range of the administrative process; it is quite another to endow the Patent Office with the power to invade the traditional area of the judiciary. For that is precisely what the plaintiff contends here, namely, that the Patent Office may declare an invalid patent to be a valid one by issuing a retroactive license to avoid the sanctions of § 185. The plaintiff contends that the power to issue an effective retroactive license after the patent has issued must necessarily be inferred from the language and history of the statutes in question.

Since it appears that this is a case of first impression, it will be useful to explore the legislative history of these sections and their predecessors. In the light of that history we shall appraise the import of *In re Lee & Heineman*, 77 USPQ 659 (1948), a case in which, on operative facts nearly identical to those now before us, the issue which we must face was resolved in favor of the patent holders.

The necessity of temporarily withholding domestic inventions from foreign exposure first became apparent during World War I when the Act of October 6, 1917, ch. 95, 40 Stat. 394 was passed. This statute contained the proviso that a United States inventor could file a patent application abroad only with the "consent or approval of the Commissioner of Patents, or under a license of the

Secretary of Commerce, as provided by law." With the advent of World War II came similar statutes (Act of July 1, 1940, ch. 501, 54 Stat. 710, amended by the Act of August 21, 1941, ch. 393, 55 Stat. 657, and further amended by the Act of June 16, 1942, ch. 415, 56 Stat. 370), which provided that:

> (5) "No person shall file * * * in any foreign country an application for patent * * * in respect of any invention made in the United States, except when authorized in each case by a license obtained from the Commissioner of Patents * * *. [A]ny person * * * shall be debarred from receiving a United States patent for an invention if such person * * * without procuring the authorization prescribed * * * made or consented to or assisted another's making application in a foreign country for a patent * * * where authorization for such application is required by the provisions of § 3, and any such United States patent actually issued to any such person, successors, assigns, or legal representatives so debarred or becoming debarred shall be invalid."

Under this statute there was no provision for a retroactive license; an unlicensed foreign filing either prevented issuance or, if the patent had issued, invalidated it. When this statute expired, the so-called Boykin Act (Act of August 8, 1946, P. L. 690, 79th Cong. 2d Sess. ch. 910, 60 Stat. 940) was passed. This legislation, a temporary post-war bill, provided for similar restrictions in regard to foreign filing and similar penalties for disregard of those restrictions. The act did provide, however, (§ 6):

> "Notwithstanding the provisions of the Act of Congress approved July 1, 1940 (54 Stat. 710; U.S.C., title 35, sec. 42), as amended by the Act approved August 21, 1941 (55 Stat. 657; U.S.C., title 35, secs. 42a-42f), and as further amended by the Act of June

16, 1942 (56 Stat. 370) no person shall be debarred from receiving a patent for an invention made in the United States, nor shall any patent issued for such invention be deemed or held invalid under said Act, merely because authorization to file an application for patent for such invention in any country foreign to the United States was not first obtained from the Commissioner of Patents: *Provided*, That the Commissioner subsequently authorized the filing of the application in such foreign country." (60 Stat. 943.)

The House Committee on Patents explains the reason for this hitherto unknown procedure, and other innovations in the bill, in H. R. 1498, Jan. 28, 1946. Prefatory remarks therein explain the general purpose of the bill:

"Certain objects of the bill are to relieve inventors of some of the hardships occasioned by the war in connection with the filing and the prosecution of applications for patent. Under any patent law it is necessary that times be fixed within (6) which certain acts must be done, such as filing the application, the taking of various steps in its prosecution, the payment of fees, etc. Failure to act within the times so specified usually results in loss or forfeiture of the right to a patent. These time limitations are quite fair and just, since their general object is promptness in the issue of patents. However, such provisions frequently result in hardship during time of war, because fulfillment of the requirements is often difficult. Delays caused by the war were particularly evident in dealings with other countries, due to the uncertainty of communication, and the fact that in many instances communication was forbidden or controlled."

In reference to the particular section of concern here, the Committee stated that:

"Patents have been granted on applications corresponding to foreign applications which were inadevert-

> ently filed by the applicants without first obtaining a license from the Commissioner of Patents as required by the act of July 1, 1940 (54 Stat. 710; U.S.C., title 35, sec. 42), as amended. In such cases where the foreign application was filed in countries allied with the United States during the war, the Commissioner subsequently issued a license. Section 6 of the bill would validate the patents in these cases where such licenses were granted."

In this context, then, this extension of the Patent Office's jurisdiction, while unusual, was nevertheless a product of exigency necessary to facilitate postwar recovery without working unjust results on inventors hampered by wartime communication problems.

It was under the authority of this statute that the Commissioner decided *In re Lee & Heineman, supra.* In that case the patentees had inadvertently, and without the required license, filed for and received a patent in Canada on an invention which corresponded to United States Patent 271,245 [*sic;* the correct number is 2,371,245]. Some three years after the issuance of the domestic patent, the patentees petitioned for and received a retroactive license under Section 6, which cured their negligent violation of Section 3. But even there the Commissioner recognized "that the authority of the Commissioner to grant licenses will expire with the expiration of Section 3 of the Act of August 21, 1941, at the end of the war." (at p. 660). These sections were omitted in the revision contained in the Act of (7) July 19, 1952, ch. 950, 66 Stat. 4, and thus repealed. The omission of the extraordinary power which Section 6 granted to the Commissioner—to cure a defective patent after it had run its administrative course—is highly significant. That statute no longer exists because the situation at which it was aimed no longer exists.

We come finally to a confrontation with the present section, 35 U.S.C.A. § 184, which has been in effect since

that revision in 1952. The plaintiff argues that it contains a savings clause which empowers the Patent Office to save its invalid patent.

> "Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after the filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. *The license may be granted retroactively where an application has been inadvertently filed abroad and the application*[4] *does not disclose an invention within the scope of section 181 of this title.*" (Emphasis added.)
>
> "The term 'application' when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof. July 19, 1952, c. 950, § 1, 66 Stat. 807."

As we stated previously, on January 4, 1965, the mandatory language of this section is clear and its meaning is unmistakable. It fulfills the aim of Congress as expressed

---

[4] We note that the very clause upon which the plaintiff relies here permits a retroactive license to issue only when the *application* discloses no harmful information; if Congress had intended to extend the Patent Office jurisdiction beyond its normal administrative reaches, it would have included the phrase "or patent" after "application." This would have opened the way for the action attempted hereby the plaintiff. Without the inclusion of such language, however, we detect nothing here which permits the Patent Office to assert itself over an application which has already ripened into a purported patent.

in the Committee Reports to permit the Government, not the individual, to determine whether the national interest might be impaired by the filing in a foreign country of an application for patent over a domestic invention and, as the Committee states, the bill changes "the temporary act of Congress now in force (8) into permanent law, *with several changes recognized as desirable as a result of experience under the temporary law and problems anticipated under a permanent law.*" 82nd Cong. 1st Sess. H. R. 828, Sept. 24, 1951, p. 4) (Emphasis added). We must conclude that one of the changes is divestiture from the Patent Office of the power to grant a retroactive license to secure patents which were invalid upon issuance because of violations of Section 184.

Whatever doubt there may be on this issue is resolved by the resounding language of Section 185, the sanctioning provision in this chapter:

> "*Notwithstanding any other provisions of law* any person, and his successors, assigns, or legal representatives, *shall not receive* a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives *shall be invalid.* July 19, 1952, c. 950, § 1, 66 Stat. 807." (Emphasis added.)

The plain fact here is that the patent did issue without a license and must be deemed invalid *ab initio*. Without specific authorization from Congress, the Commissioner is powerless to affect the validity or invalidity of a patent after it has egressed from administrative channels. Conse-

quently, the purported retroactive license issued on January 8, 1965 is inoperative, and the plaintiff's Motion for Reconsideration of the Court's Order of January 4, 1965 must be overruled. It is so ordered.

Decision, January 4, 1965 of the United States District Court for Northern District Ohio, Eastern Division

(49) The Court: We are here immediately to decide on the question of the Defendants' motion for summary judgment.

There is no question but that patent law is a great speciality; so much so that it seems to those who practice general law that patent lawyers have even a language of their own. And they know their business best, and they know all of the statutes with great familiarity with which we are here concerned.

We have here a chapter 35, paragraph 181, on the secrecy of inventions. It may be as Mr. Koykka has said, that the statutes came into existence by reason of the necessity for protecting the national safety. But the statutes with which we are here involved do not specifically mention the proposition that only parents pertaining to national safety come within the purview of the statute.

Section 181 begins with the proposition that whenever publication or disclosure by the grant of a patent on an invention in which the Government has a property interest might, in the (50) opinion of the head of the interested Government agency, be detrimental to the national security, the Commissioner upon being so notified shall order that the invention be kept secret and shall withhold the grant of a patent therefor under the conditions set forth hereinafter.

It has a chapter pertaining to the situation where the Government does not have a property interest. And it goes into details as to how the secrecy shall be preserved, and then says in its last paragraph:

"An invention shall not be ordered kept secret and the grant of a patent withheld for a period of more than one year." That is Section 181.

Section 182 has to do with the abandonment of an invention for an unauthorized disclosure. Section 183 has to do with rights of compensation if a person loses through the inability to have marketed his product sooner, that sort of thing. Then we come down to Sections 184 and 185 with which we are here concerned.

Now I have said patent lawyers have a great specialty. However, any lawyers, whether they specialize or not in patent law, can understand (51) the language and the meaning of these sections without any difficulty whatsoever. Section 184 reads as follows:

"Filing of application in foreign country. Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to Section 181"—which is the first section we read of this Title—"without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of Section 181 of this Title."

The last paragraph, of which much has been said here reads as follows:

(52) "The term 'application' when used in this Chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof."

Section 185 is the section about which much has been said and reads as follows:

"Patent barred for filing without license. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in Section 184 of this Title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid."

So what the law says—it is patent law, but anyone who reads general law can understand it, and anyone who reads English can understand it—what it says in effect is that before you file in (53) a foreign country for a patent, meaning an application for a patent, you must comply with Section 184, or you lose your patent under Section 185.

Now, then, something has been said about the decision in the Seventh Circuit. It is here claimed by the defense that the case before us now is on all fours with the Seventh Circuit, and denied by the Plaintiff's side of the case. The Seventh Circuit was concerned with the same sections which I have just read. It was decided in the Court of Appeals of the Seventh Circuit, Beckman Instruments, Inc., et. al., vs. Coleman Instruments, Inc., decided November 9, 1964. So it was decided within two months. I will read the parts of it which I think concern us here, and because there is a controversy as to whether it has application.

"On March 19, 1951, Frediani filed United States patent application Serial No. 216,325 (first application), and on

November 22nd, 1952, filed United States patent applications Serial No. 322,064 (second application), which resulted in the issuance of a patent in suit on April 3rd, 1956. Subsequent to the second (54) application, the first application was rejected by the patent examiner as being inoperative. The second application recited that it was 'a continuation-in-part of' the first application. Frediani in his oath attached to his second application stated that there were currently being filed applications for patents in Great Britain and West Germany. The former was filed November 7, 1952, and the latter November 24, 1952. No license was obtained by Frediani from the Secretary of Commerce or the Commissioner of Patents with respect to either of said foreign patents applications."

I should say in passing that the case there involved a chemical process of some kind. The Court went on to say, referring to these laws—these particular sections which that court said had not been construed before—so this could be the second time:

"One. In summary, these provisions"—having to do with Sections 184 and 185—"expressly provide that an applicant for a patent who files an application in a foreign country must (1) delay such foreign filing for six months after the filing of his corresponding United States patent (55) application, or (2) obtain a license authorizing such foreign filing in less than the mandatory six months' waiting period. The statute provides that any United States patent issued in violation of these specific requirements shall be invalid."

And you note the language "any." "Any United States patent issued in violation of these specific requirements shall be invalid."

"The crucial question is whether the six months' waiting period for the filing of the foreign applications commenced to run at the time Frediani filed his first application, which

he abandoned, or his second application, upon which the patent in suit issued. Plaintiffs argue that it was the former; Defendant, that it was the latter." Which, gentlemen, is similar to the question we have here. "The District Court sustained Defendant's contention, which resulted as a matter of law in a judgment in its favor.

"Plaintiffs' main argument is that both applications were for the same invention and that the second, being a continuation-in-part, is entitled to the same filing date as the first. In the same vein it is argued that the foreign (56) applications were for the same invention as that described in the first application. The deposition of Frediani, and more particularly the oath made in support of his seceond application, which were made a part of Defendants' motion for summary judgment, refute Plaintiffs' contention.

"Frediani in his oath stated: '* * * that this application is a continuation-in-part of my prior application Serial No. 216,325, filed March 19, 1951, that as to subject matter disclosed in said prior application, I do not know and do not believe that this invention was ever known or used before my invention or discovery thereof, * * * that as to the subject matter disclosed, in this application, but not disclosed in said prior application, I do not believe that the invention was ever known or used before my invention or discovery thereof, * * * and that no application for patent on this invention or discovery has been filed by me or my representatives or assigns in any country foreign to the United States except as follows: Great Britain and West Germany (currently being filed). (Emphasis supplied).'

"Thus, in this quote he distinguishes his (57) second invention from the first with the statement that the latter contained subject matter not disclosed in the former. That the examiner recognized the distinction as material is shown from the fact that he refused a patent on the first

application but allowed it on the second. Furthermore, Frediani in his oath stated that the foreign applications were 'currently being filed' on 'this' invention, referring to that disclosed in his second application.

"The second paragraph of Section 184 (previously omitted) provides: 'the term 'application' when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.'

"By this paragraph the term 'application' as employed in the statute includes 'any modifications, amendments, or supplements thereto, or divisions thereof.' Even under Plaintiffs' theory, it is not open to doubt that the subject matter of the second application was a modification, amendment or supplement to the first. It follows that the foreign applications filed within six months after the filing of the second application, without obtaining a license, invalidated the (58) patent.

"2. This construction is consistent with the purpose of the statute, which is to provide for the temporary withholding of all patent disclosures to ascertain if foreign filing might be detrimental to the natonal security. The specified six months' waiting period affords the Secretary of Commerce and other Governmental departments an opportunity to examine the application for the presence of security material before the information is sent abroad. The statute would fail of its purpose if an applicant were permitted to file a first application disclosing some features of a secret invention; after a six-month period to file a continuation-in-part application disclosing additional essential features, and then without obtaining a license to disclose his invention abroad. It is logical to believe that the insertion of the second paragraph in Section 184 was intended to preclude such a result.

"3. Plaintiffs greatly stress the universal rule that the issuance of a patent carries with it the presumption of

validity. No purpose could be served in discussing cases cited by Plaintiffs (59) in that respect. It is enough to say that the presumption cannot save a patent issued in contravention of the terms of the statute.

"4. Section 184 is applicable 'only in respect of an invention made in this country.' Plaintiffs contend that there is no evidence and no finding by the Court that the Frediani applications were for inventions made in this country. While there is no direct evidence on this point, we think the fact may be reasonably inferred from the circumstances in proof. In any event, no such question was raised in the District Court in argument, pleadings or otherwise which in all probability is the reason that no finding was made on this issue. It is not necessary to cite cases for the well-established rule that this defense cannot be successfully maintained for the first time on appeal.

"In our judgment, the record reveals no genuine issue as to any material fact. In the main, the issue presents a question of law, that is, an interpretation of the statute and its application to the facts of the case. It is our conclusion and we so hold that the patent was issued in contravention of the statute and is, (60) therefore, invalid."

Now let's get down to our immediate facts. I first go to Defendants' motion for summary judgment in a recital of its claims as a basis for its motion here for summary judgment. In the first paragraph on Page 1 they say:

"The material facts as to which there is no genuine issue, as shown by public records, are now listed, reference being made to exhibits attached hereto which are true copies of the public documents involved.

"1. Plaintiff did on October 8, 1958, file in the U. S. Patent Office an application for patent in the names of its employees Howard L. Hoover, Eugene J. Dupre and Walter J. Rankin, which application was given Serial No. 777,167. A certified copy of the application and all proceedings

thereon (the Patent Office wrapper and contents) is attached hereto as Exhibit A.

"2. On January 20, 1959, less than six months after said filing of 777,167, Plaintiff caused to be filed in Australia a patent application based upon an essentially a copy of said 777,167, this being Australian Application No. 45,148/59, which later materialized into Australian (61) Patent 230,115."

We find here in evidence, also, that as of dates very close, applications were filed in four other countries. We mentioned Australia. We find that in Argentina under application 153,295 an application was filed on 1-22-59; that in Italy one was filed on 1-22-59; that in Japan one was filed on 1-24-59; and Sweden on 1-19-59. The one concerning which there is primary proof here, in Australia, having been filed on 1-20-59. So we have five filed in foreign countries within a five-day period, all within the six-month period described herein.

"3. Application 777,167 and the Australian application are substantially copies of one another, practically all of the text being verbatim copy.

"4. The U. S. Patent Office on January 12, 1959, received from a Chicago law firm, Langner, Parry, Card & Langner, a request for license (attached hereto as Exhibit G) for foreign filing of applications based on 777,167.

"5. On February 9, 1959, the Patent Office mailed to Langner, Parry, Card & Langner, a license for foreign filing, dated February 5, 1959, license number 250,351, attached hereto as Exhibit D. (62) This document states, 'this license is not retroactive unless specifically indicated.' The license contains no indication of retroactive effect.

"6. On February 21, 1957, the Plaintiff did file in the U. S. Patent Office an application for patent which became Serial No. 641,714, which was related to a certain extent to

the subject matter of 777,167. However, 641,714 did not contain certain substantial additional disclosure introducing new subject matter, which new matter is in both the Australian application and U. S. 777,167. A certified copy of 641,714 and the prosecution record thereof (file wrapper and contents) is attached hereto as Exhibit E.

"7. On January 11, 1960 Plaintiff did file still a third U. S. application Serial No. 1453 which included all of the disclosure of the second U. S. application 777,167, but added still further subject matter. Contrary to the requirements of the Patent Office as to the contents of the oath, Plaintiff failed to mention the then pending Australian application in the oath. A certified copy of Serial No. 1453 is attached hereto as Exhibit F.

(63) "8. The purported inventive activity of Hoover, Dupre and Rankin occurred in the United States. This is shown by the depositions of these persons, the transcripts of which are on file with this Court."

Now these eight particular allegations so set forth I hereby find in findings of fact herein.

Gentlemen, I do not believe that an applicant for a patent has a right to make the decision that the thing on which he asks a patent is or is not of some military value to the country, or is or is not involved in national defense.

Plaintiffs have here filed a patent suit on some kind of a scouring pad. In the Beckman case it had something to do with some chemical. If it had something to do with a paper napkin or a hemstitched handkerchief or a ball point pencil, or whatever the subject of the patent, it is not for the applicant to decide that Section 184 has no application to him. That is not his function. That is not his privilege. That is really not his business. It is the country's business.

Congress enacted this law to get sufficient control of anybody who applies for any kind of a patent so that the

thing for which he applies for (64) a patent in this country shall not be made available—since it originated in this country—it will not be made available to any foreign country in which applicant seeks another patent, unless he complies with this Section 184. He must go to the Commissioner or somebody connected with the United States Government who has to make the decision as to whether or not the information pertaining to the patent he seeks is good for us to permit to get into a foreign country. And the country in some one phase of its agencies or some one branch, particularly in its Patent Office, under the law has the right and duty of deciding whether or not this particular information should get out.

So when counsel says "But this has nothing to do with war, this has nothing to do with guns, this didn't go into the composition of a bomb, and, therefore, one should consider it as a very trifling incident, we should really pay no attention to it and should liberally construe the statute" —when counsel for Plaintiff says that to me—I have to say to counsel for Plaintiff, "Gentlemen, we must go to the law." And I will say again, patent lawyers must know all about these (65) laws. Other lawyers may not know about them until they look them up, until they are called to their attention. There is no question about the language here, and the Beckman decision certainly tells us what we have to do. There isn't any question here but what you are almost on all fours on your points.

You cannot by modifications enlarge your time. You cannot by amendments or supplements or divisions change the statute. The same question was raised in Beckman and decided, and I don't think any good lawyer or any good judge can disagree with it.

You say, well, do not give me a strict construction. Judges do not give strict constructions, and judges do not give liberal constructions. We can no more say, well, you are going to get a liberal construction than you can say,

well, this is military. The law is the law. It is as clear as it can be.

Patents carry great privileges and rights, in order to protect and foster invention. But these statutes here involved obviously are intended to make national interest paramount to those of inventors, if only for a very short time. These (66) statutes make the right of inventors secondary to those of the country; they require a six-month submission to proper governmental authority of the information contained in a patent application, as a condition precedent to filing the same information with other governments, under penalty of losing one's patent rights for failure to comply.

The applicant receives compensation for any loss occasioned to him by such delay, so it does him no harm whatsoever to obey the law. All persons are presumed to know the law. Specialists in patent law cannot help but know these laws. When an applicant presumes that because in his own judgment his product does not concern national safety, he disregards those statutes at his own risk. When he presumes that since "no damage has been done to the country" by his failure to follow this law, and for that reason that he is entitled to what he calls a "liberal" construction of the statute, he does so at his own risk.

We have no choice but to follow the law. Plaintiff should have done so to protect our country in the way in which Congress decided our country should be protected. Obviously, if an applicant chooses to file in a foreign country within six months of (67) filing in our country, he loses the rights our country gave him. Since he knows of such forfeit in advance, how can he complain? Here plaintiff says, in effect, that it didn't really take this law very seriously. It says it really did no harm. It says that its disobedience to the law entitles it to a "liberal" construction. This Court must say that by plaintiff's refusal

to comply with the law it has invalidated the patent rights this country sought to give it.

If plaintiff's own opinion that its patent did not involve national security would be a defense to the statute on invalidation, then all other applicants would be entitled to equal defense, in which case, opinions of applicants would nullify this law in toto.

We hold that this law is not nullified simply because this plaintiff ignored it.

I will follow the Beckman case and I grant the motion for summary judgment filed by the defense for the reasons given, and to which you take your exceptions.

That is all, gentlemen.

(68) Mr. Koykka: Before your Honor leaves the bench, may we consult with counsel. We may have a further request of the Court.

The Court: All right.

Mr. Haight: May it please the Court, I hope I can make the oral motion to request your Honor to withhold actual entry of judgment until we can get action from the Patent Office. As we indicated in argument, and I believe in the brief, we have an application for amendment of the prior license already granted, or the granting of a new license. We have that pending with a showing, as we believe, of inadvertence.

We could make that in a very formal written motion, if your Honor would prefer, but we would like to have judgment withheld until we can—

The Court: As far as I am concerned you get in your findings of fact and conclusions of law in accordance with what I said to you, and you are supposed to do that in 10 days.

That's all.